

REMARKS

Claim Rejections Under 35 U.S.C. § 112

Claims 1, 3-6, 8-11, 21 and 22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that the Specification does not reasonably suggest that controller 112 limits the list of network devices to those of similar imaging devices. Applicant respectfully traverses.

Applicant notes that the controller 112 is a processor. Specification, paragraph 0004 (“In imaging device 110, a processor or controller 112 is coupled to the network interface . . .”). Applicant further notes that embodiments of imaging devices are taught to include a management facility and that management facilities include computer-readable instructions for execution by a processor. *See*, Specification, paragraph 0020 (“Specific embodiments of the present invention include . . . imaging devices that can store a list of imaging devices and include an embedded management facility or function, such as an embedded webserver.”); and paragraph 0021 (“In general, however, the management facility includes a set of computer-readable instructions stored on a computer-usable medium for execution by a processor.”). Applicant contends that it is inherent that a management facility of an imaging device has instructions for execution of the processor, or controller, of that imaging device.

Applicant’s original claim 13 recited, “A computer-usable medium having computer readable instructions stored thereon for execution by a processor to perform a method comprising: determining a list of network addresses for other imaging devices similar to an imaging device; storing the list of network addresses on the imaging device; and communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices.” Applicant thus contends that one skilled in the relevant art would recognize that Applicant, at the time the application was filed, had possession of subject matter of a controller of an imaging device limiting a list of network devices to those of similar imaging devices. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, and allowance of claims 1, 3-6, 8-11, 21 and 22.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 3-6, 8-11 and 13-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Danknick (U.S. Patent No. 6,021,429) in view of the HTTP 1.0 Specification (Request for Comments: 1945, Berners-Lee et al., May 1996) and Sugiyama (U.S. Patent No. 6,965,958). Applicant respectfully traverses.

The Office Action acknowledges, “But, Danknick does not expressly disclose that the controller (NEB) is adapted to limit the list of other imaging device network addresses (list of device addresses in the NEB) to those other imaging devices that are similar to the imaging device (printer).” Office Action, page 6, section 2, first paragraph. The Office Action then relies on Sugiyama to cure this admitted deficiency. However, Applicant contends that Sugiyama cannot be used to modify the Danknick reference as suggested.

The proposed modification cannot render the prior art unsatisfactory for its intended purpose. MPEP § 2143.01(V). Danknick purports to address a need to maintain a list of network device addresses without the addition of a separate server. *See, e.g.*, Danknick, column 1, lines 37-50 (“Accordingly, there exists a need for a system of maintaining a list of device addresses for a LAN which does not require the addition of a separate server to the LAN. . . . The present invention addresses the foregoing need By controlling a device on the LAN to maintain a list of device addresses for the LAN, the present invention is able to alleviate the need for a file server to maintain such a list.”). By limiting the list of Danknick to only similar imaging devices, the purpose of Danknick is defeated, i.e., if the list of Danknick is limited, a separate server would again be required to maintain the full list of network devices. As such, Applicant contends that Sugiyama cannot be used to modify Danknick in a manner required to support the rejection as the resulting combination would render Danknick unsatisfactory for its intended purpose.

Furthermore, the Sugiyama reference also does not purport to limit its stored list of network devices to similar devices. While Applicant acknowledges that Sugiyama performs a search function to identify network devices that match inquiry information received from a client, Sugiyama still maintains a full directory table of network devices. *See, e.g.*, Sugiyama, column 4, lines 14-17 (“FIG. 3 is a directory table showing attributes of the network devices.

The directory table has been stored as registration information of the directory in the HD 24 of the search server 10.”); column 9, lines 52-54 (“A database, namely, the directory table (refer to FIG. 3) is searched and the device which is matched with the inquiry information from the client is selected.”); and column 10, lines 7-9 (“Subsequently, step S44 follows and whether the whole directory table (FIG. 3) has completely been searched or not is discriminated.”). Because the Office admits that Danknick does not expressly disclose that its controller is adapted to limit the list of other imaging device network addresses to those other imaging devices that are similar to the imaging device, and because Sugiyama also does not purport to limit its list, Applicant contends that the cited combination must also fail to teach or suggest that a controller is adapted to limit its list of other imaging device network addresses to those other imaging devices that are similar to the imaging device having the controller.

Claim 1 recites, in part, “wherein the controller is further adapted to discover the list of other imaging device network addresses and to limit the list of other imaging device network addresses to those other imaging devices that are similar to the imaging device.” Claim 13 recites, in part, “determining a list of network addresses limited to other imaging devices similar to a first imaging device” Claim 15 recites, in part, “determining a list of network addresses and supplemental information limited to other imaging devices similar to a first imaging device” In view of the foregoing, Applicant contends that the cited references, taken either alone or in combination, fail to teach or suggest at least these elements of claims 1, 13 and 15. As claims 3-6, 8-11, 21 and 22 include all patentable elements of claim 1, claim 14 includes all patentable elements of claim 13, and claims 16-20 include all patentable elements of claim 15, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 1, 3-6, 8-11 and 13-22.

CONCLUSION

Claims 1, 3-6, 8-11 and 13-22 are currently pending.

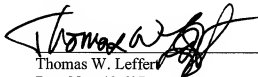
In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2204.

Respectfully submitted,

Date:

30 APR 08



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